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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,654	03/15/2002	Douglas B. Buchanan	318 P002	2980

7590 12/30/2003

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

10/099,654

Applicant(s)

BUCHANAN, DOUGLAS B.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12,14-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12,14-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office action is responsive to communication received 10/14/2003 (c.m. 10/09/2003); 12/06/2003 – IDS.

Claim 4 has been canceled, as directed.

Claims 1-3, 5-12, 14-16 and 18 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Swash in view of Yamaguchi and the Rules of Golf as set forth by the USGA, as set forth in the last Office action, mailed 04/09/2003.

Claims 5-12, 14-16 and 18 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Swash in view of Yamaguchi, Rules of Golf and Igarashi, as set forth in the last Office action, mailed 04/09/2003.

### **RESPONSE TO ARGUMENTS**

In the arguments received 10/14/2003, the applicant contends that the content from the Rules of Golf cited within the outstanding rejections does not apply to putter-type club heads. The applicant further argues that the cited art references to Yamaguchi and Igarashi are not applicable to the present invention, since these references relate to iron-type club heads, not putters. In addition, the applicant

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contends that there is no suggestion in any of the prior art references to modify the groove depth of the Swash device, since the Swash patent does not recognize a change in the way that a struck ball rolls in connection with a change in groove depth of the striking face. Further arguments by the applicant set forth that the milling process by Igarashi is inapplicable when combined with the Swash patent, since Igarashi produces sharp edges in the groove pattern. The applicant comments that the non-concentric feature of the claimed groove pattern offers advantages not advanced through the prior art. Last, the applicant contends that the prior art does not teach or suggest an insert being spaced from the head by means of a clearance.

In response to these arguments, it is noted that the claims have been rejected under 35 USC §103(a). Section 103 requires that a presumption of full knowledge by the inventor of the prior art in the field of his endeavor be present. See In re Winslow, 151 USPQ 48 (CCPA 1966). Here, the field of endeavor is not limited to putter-style clubs, but instead includes all teachings related to groove markings in the golf club art. Thus, the references to Yamaguchi and Igarashi, though directed to iron-type club heads, are deemed to be fully applicable to the field of putters for the their respective teachings of groove design and milling techniques for groove patterns.

Specific to Igarashi, this patent is applied to show only that a milling procedure is well known in the golf club art to fashion markings on the face. In other words, the teaching by Igarashi would not have implied to the skilled artisan or have led the skilled artisan to believe that a milling operation would have only been useful to produce sharp groove designs.

As to the clearance space used when securing the insert to the club head body, the outstanding rejection of claims 5-12 is deemed to have already provided an exhaustive explanation of why the skilled artisan would have found it obvious to provide a clearance feature on a modified Swash device. No further explanation is deemed necessary, here.

With respect to the non-concentric style of the face markings, there would not appear to be any unexpected result or otherwise unobvious reasons for the use of non-concentric grooves over the more commonly seen horizontal, parallel-style grooves. In other words, the reason for having grooves on a putter as well as the effect of grooves on a struck ball is well documented.

Regarding the citation from the USGA Rules of Golf, the same citation noted by the applicant (Appendix II, Section 5, Subsection F) indicates that the specifications with respect to face markings "do not usually apply". This statement does not preclude the application of other provisions under the USGA guidelines to the groove pattern on putters. For example, the USGA notes an exception when the groove dimensions of putters exceed a specific depth and width. As with the argument advanced when discussing the rejection of the claims based upon the Swash reference, a similar reasoning applies when one interprets the Rules of Golf regarding face markings. In other words, the USGA Rules as well as the Swash teaching urge restraint when designing the maximum groove dimensions. There are however no details restricting the minimum dimensions of the grooves. For example, the USGA states that the face of the club "may" be provided with grooves. Further, Yamaguchi details that the face may

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or may not be provided with markings and advances specific reasons for each scenario. In addition, the Swash patent is quick to recognize that the grooves alter the spin of the ball and may have an effect on the roll of the ball. Thus, the skilled artisan would have been motivated to vary the groove dimensions in the Swash device to simply alter the ball-striking characteristics of the striking face.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3579.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
December 24, 2003